RECORD AND BRIEFS

Supreme Court, U.S.
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No. 16-712

In the Supreme Court of the United States

OIL STATES ENERGY SERVICES, LLC,
Petitioner,

v.

GREENE'S ENERGY GROUP, LLC, ET AL.,
Respondents.

On Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

BRIEF OF 27 LAW PROFESSORS AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

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QUESTION PRESENTED

Whether *inter partes* review—an adversarial process used by the Patent and Trademark Office (PTO) to analyze the validity of existing patents--violates the Constitution by extinguishing private property rights through a non-Article III forum without a jury.

TABLE OF CONTENTS

Question Presented i

Table of Authorities iii

Interest of *Amici Curiae* 1

Summary of Argument 1

Argument 6

I. Since the Early American Republic, This Court and Lower Federal Courts Have Defined Patents as Private Property Rights 6

II. This Court Has Provided Constitutional Protection to Patents as Private Property Rights for Two Hundred Years 10

III. This Court Recently Reaffirmed That Patents are Private Property Rights Secured Under the Constitution 17

Conclusion 19

Appendix A – Full List of *Amici Curiae* A-1

TABLE OF AUTHORITIES

Page(s)

Cases

Allen v. New York,
1 F. Cas. 506 (C.C.S.D.N.Y. 1879) 9

Atlas Roofing Co. v. Occupational Safety & Health Review Comm'n,
430 U.S. 442 (1977) 16

Ayling v. Hull,
2 F. Cas. 271 (C.C.D. Mass. 1865) 10

Ball v. Withington,
2 F. Cas. 556 (C.C.S.D. Ohio 1874) 9

Batten v. Silliman,
2 F. Cas. 1028 (C.C.E.D. Pa. 1855) 7

Brooks v. Byam,
4 F. Cas. 261 (C.C.D. Mass. 1843) 6

Buck v. Cobb,
4 F. Cas. 546 (C.C.N.D.N.Y. 1847) 7

Burleigh Rock-Drill Co. v. Lobdell,
4 F. Cas. 750 (C.C.D. Mass. 1875) 7

Butner v. United States,
440 U.S. 48 (1979) 5

Cammeyer v. Newton,
94 U.S. 225 (1876) 12, 13, 16, 18

Carew v. Boston Elastic Fabric Co.,
5 F. Cas. 56 (C.C.D. Mass. 1871) 9

Carr v. Rice,
5 F. Cas. 140 (C.C.S.D.N.Y. 1856) 7

Cascades Projection LLC v. Epson Am., Inc.,
864 F.3d 1309 (Fed. Cir. 2017) 12

Crowell v. Benson,
285 U.S. 22 (1932) 5

Davoll v. Brown,
7 F. Cas. 197 (C.C.D. Mass. 1845) 10

Dobson v. Campbell,
7 F. Cas. 783 (C.C.D. Me. 1833) 6, 7

Earle v. Sawyer,
8 F. Cas. 254 (C.C.D. Mass. 1825) 8

Eastman v. Bodfish,
8 F. Cas. 269 (C.C.D. Me. 1841) 7

eBay Inc. v. MercExchange, L.L.C.,
126 S. Ct. 1837 (2006) 19

Ex parte Wood,
22 U.S. (9 Wheat.) 603 (1824) 6

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,
535 U.S. 722 (2002) 19

Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank,
527 U.S. 627 (1999) 3, 19

Gay v. Cornell,
10 F. Cas. 110 (C.C.S.D.N.Y. 1849) 10

Gayler v. Wilder,
51 U.S. (10 How.) 477 (1850) 8

Goodyear Dental Vulcanite Co. v. Van Antwerp,
10 F. Cas. 749 (C.C.D.N.J. 1876) 7

Grant & Townsend v. Raymond,
10 F. Cas. 985 (C.C.S.D.N.Y. 1829) 8

Gray v. James,
10 F. Cas. 1019 (C.C.D. Pa. 1817) 9

Hayden v. Suffolk Mfg. Co.,
11 F. Cas. 900 (C.C.D. Mass. 1862) 10

Horne v. Dep't of Agric.,
135 S. Ct. 2419 (2015) 2, 17, 18

Hovey v. Henry,
12 F. Cas. 603 (C.C.D. Mass. 1846) 7

James v. Campbell,
104 U.S. 356 (1882) 3, 5, 18

Lightner v. Kimball,
15 F. Cas. 518 (C.C.D. Mass. 1868) 10

Livingston v. Jones,
15 F. Cas. 669 (C.C.W.D. Pa. 1861)
(*rev'd by Jones v. Morehead*,
68 U.S. 155 (1863)) 7

McClurg v. Kingsland,
42 U.S. (1 How.) 202 (1843) 10-12, 16

McCormick Harvesting Mach. Co. v. C. Aultman & Co.,
169 U.S. 606 (1898) 12, 18

McKeever v. United States,
14 Ct. Cl. 396 (1878) 13-16

MCM Portfolio LLC v. Hewlett-Packard Co.,
812 F.3d 1284 (Fed. Cir. 2015) 2, 4, 12, 16

Moore v. Marsh,
74 U.S. (7 Wall.) 515 (1868) 9

Pennock v. Dialogue,
27 U.S. (2 Pet.) 1 (1829) 7, 8

Potter v. Holland,
19 F. Cas. 1154 (C.C. Conn. 1858) 9

Russell v. United States,
182 U.S. 516 (1901) 13

Soc'y for the Propagation of the Gospel in Foreign Parts v. New Haven, 21 U.S. (8 Wheat.) 464 (1823) 11

Stern v. Marshall, 131 S. Ct. 2594 (2011) 5

Suydam v. Day, 23 F. Cas. 473 (C.C.S.D.N.Y. 1845) 9

Tull v. United States, 481 U.S. 412 (1986) 16

United States v. Buffalo Pitts Co., 234 U.S. 228 (1914) 13

United States v. Burns, 79 U.S. 246 (1870) 12, 16

Vanhorne's Lessee v. Dorrance, 2 U.S. (2 Dall.) 304 (1795) 15

Winans v. Denmead, 56 U.S. (15 How.) 330 (1853) 19

Constitutional Provision & Statute

U.S. Const. art. I, § 8, cl. 8 14

35 U.S.C. § 261 3

Other Authorities

Adam Mossoff, *Patents as Constitutional Private Property: The Historical Protection of Patents Under the Takings Clause*, 87 B.U. L. Rev. 689 (2007) 3

Adam Mossoff, *Exclusion and Exclusive Use in Patent Law*, 22 Harv. J. L. & Tech. 321 (2009) 3

The Federalist No. 43, at 271-72 (James Madison) (Clinton Rossiter ed., 1961) 4

Gregory Dolin & Irina D. Manta, *Taking Patents*, 73 Wash. & Lee L. Rev. 719 (2016) 17

Theodore D. Woolsey et al., *The First Century of the American Republic* 443 (1876) 15

INTEREST OF *AMICI CURIAE*[1]

The *amici curiae* are 27 law professors who teach and write on patent law, property law, and constitutional law. They have an interest in both promoting continuity in the evolution of these interrelated doctrines and ensuring that the patent system continues to secure innovation to its creators and owners. They have no stake in the parties or in the outcome of the case. Although *amici* may differ amongst themselves on other aspects of patent law and constitutional law, they are united in their professional opinion that this Court should reverse the Court of Appeals for the Federal Circuit's decision in this case because it fails to protect the constitutionally secured private property rights of patent owners. This failure undermines the constitutional function of the patent system in promoting innovation. The names and affiliations of the *amici* members are set forth in Appendix A.

SUMMARY OF ARGUMENT

The decision by the Court of Appeals for the Federal Circuit directly contradicts this Court's longstanding case law that secures constitutional protections for private property rights in patents. The Petitioner fully addresses the specific legal and

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1. All parties have consented to the filing of this brief. No counsel for any party authored this brief in whole or in part, and no person or entity, other than *amici* or their counsel, made a monetary contribution intended to fund the preparation or submission of this brief.

constitutional issues concerning these private property rights protected under the Seventh Amendment. *Amici* offer additional support by identifying the substantial case law from this Court and lower federal courts reaching back to the early American Republic that patents are private property rights secured under the Constitution. Thus, the Federal Circuit is mistaken in concluding that patents are "public rights" that exist solely at the administrative prerogative of the sovereign, a key legal premise in this case and in many others since the Federal Circuit's decision in *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1293 (Fed. Cir. 2015). This mistake has infected many of the Federal Circuit's decisions affirming actions by the Patent Trial & Appeal Board (PTAB) at the United States Patent & Trademark Office. This is a predicate issue underlying whether the Seventh Amendment or any other constitutional provision or doctrine applies to the private property rights in patents, and thus it must be resolved in this case.

This Court has long recognized and secured the constitutional protection of patents as *private property rights* reaching back to the early American Republic. Just two terms ago, this Court confirmed the continuing vitality and relevance of the revered legal proposition that patents are private property rights in *Horne v. Department of Agriculture*, 135 S. Ct. 2419, 2427 (2015) (Roberts, C.J.), in which the Court approvingly quoted one of its own nineteenth-century decisions that "[a patent] confers upon the

patentee an exclusive property in the patented invention which cannot be appropriated or used by the government itself, without just compensation, any more than it can appropriate or use without compensation land which has been patented to a private purchaser" (quoting *James v. Campbell*, 104 U.S. 356, 358 (1882)). This Court also held seventeen years ago that patents are property rights secured under the Due Process Clause of the Fourteenth Amendment. *See Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999).

To establish the extensive and binding historical case law that supports this Court's recent decisions affirming the private property rights in patents under the Constitution, *amici* detail these nineteenth-century cases. These decisions are overwhelming evidence for the public meaning in early American courts that patents are private property rights protected by the Takings Clause and Due Process Clause. *See* Adam Mossoff, *Patents as Constitutional Private Property: The Historical Protection of Patents Under the Takings Clause*, 87 B.U. L. Rev. 689, 700–11 (2007) (discussing this case law). Congress explicitly endorsed this case law in the 1952 Patent Act in codifying the legal definition of patents as "property" in 35 U.S.C. § 261. *See* Adam Mossoff, *Exclusion and Exclusive Use in Patent Law*, 22 Harv. J. L. & Tech. 321, 343–45 (2009) (discussing the text and legislative history of § 261 as "codify[ing] the case law reaching back to the early American Republic that patents are property rights").

Respondent and its supporting *amici* will likely argue that the public (or its delegated agents in the government) has an interest in the validity of a patent given that it is a property right granted and secured under federal law, and that this interest is sufficient to classify it as a "public right" on par with other modern regulatory entitlements. *See MCM Portfolio*, 812 F.3d at 1292-93 (citing only modern administrative law cases). But this assertion proves too much; it is a truism about all private rights. As James Madison recognized in *The Federalist No. 43*, "the copyright of authors had been solemnly adjudged, in Great Britain, to be a right of common law," and that the "right to useful inventions seems with equal reason to belong to the inventors." *The Federalist No. 43*, at 271-72 (James Madison) (Clinton Rossiter ed., 1961). As with all private rights, such as the rights to liberty, property, and contract, Madison concluded that "the public good fully coincides in both [patents and copyrights] with the claims of individuals." *Id.* at 272.

Any appeal to a highly generalized "innovation policy" goal in the patent system is not a coherent ground in policy or law for defining an entire class of private property rights as "public rights." First, it directly contradicts the weight of this Court's longstanding decisions to the contrary, holding that patents are private property rights. Second, it contradicts this Court's recent discussion in *Stern v. Marshall*, 131 S. Ct. 2594, 2612 (2011), that the "public rights exception" does not apply to matters of

"private right, that is, of the liability of one individual to another under the law as defined" (quoting *Crowell v. Benson*, 285 U.S. 22, 50 (1932)). In their alienation in the marketplace (via license or assignment) and in their enforcement, patents are quintessential property rights in which rights and liabilities exist solely between individuals "under the law as defined." *Id.* The fact that patents are uniquely federal property rights, whereas most other "property interests are created and defined by state law," *Butner v. United States*, 440 U.S. 48, 55 (1979), is a distinction without a difference under this Court's binding case law reaching back to the early American Republic.

The Federal Circuit's decision in this case directly conflicts with both modern and long-established decisions on the constitutional protection of patents as private property rights. The result of this contradiction with this Court's jurisprudence on patents has a far-reaching, negative impact for the protection of all "exclusive property" under the Constitution. *James*, 104 U.S. at 358. The Court should reaffirm expressly its extensive case law that patents are private property rights, which are secured as such under the Constitution, and reverse the Federal Circuit's contrary decision.

ARGUMENT

I. SINCE THE EARLY AMERICAN REPUBLIC, THIS COURT AND LOWER FEDERAL COURTS HAVE DEFINED PATENTS AS PRIVATE PROPERTY RIGHTS.

This court unequivocally defined patents as property rights in the early American Republic. In 1824, for instance, Justice Joseph Story wrote for a unanimous Supreme Court that the patent secures to an "inventor . . . a property in his inventions; a property which is often of very great value, and of which the law intended to give him the absolute enjoyment and possession." *Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 608 (1824). In deciding patent cases while riding circuit, Justice Story explicitly relied on *real property* case law as binding precedent in his opinions.[2] Justice Story was not an outlier, as many Justices and judges repeatedly used common-law property concepts in patent cases, such as defining a

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2. *See, e.g.*, *Brooks v. Byam*, 4 F. Cas. 261, 268-70 (C.C.D. Mass. 1843) (No. 1,948) (Story, Circuit Justice) (analogizing a patent license to "a right of way granted to a man for him and his domestic servants to pass over the grantor's land," citing a litany of real property cases and commentators at common law, such as *Lord Coke's Institutes*, *Coke's Littleton*, *Viner's Abridgment*, and *Bacon's Abridgement*); *Dobson v. Campbell*, 7 F. Cas. 783, 785 (C.C.D. Me. 1833) (No. 3,945) (Story, Circuit Justice) (relying on real property equity cases in which "feoffment is stated without any averment of livery of seisin" in assessing validity of patent license).

patent as a "title" in an invention,[3] identifying patent infringement as a "trespass,"[4] and referring to infringement of a patent as "piracy."[5]

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3. *See, e.g.*, *Carr v. Rice*, 5 F. Cas. 140, 146 (C.C.S.D.N.Y. 1856) (No. 2,440) (noting that "assignees [of a patent] become the owners of the discovery, with a perfect title," and thus "[p]atent interests are not distinguishable, in this respect, from other kinds of property"); *Hovey v. Henry*, 12 F. Cas. 603, 604 (C.C.D. Mass. 1846) (No. 6,742) (Woodberry, Circuit Justice) (instructing jury that "[a]n inventor holds a property in his invention by as good a title as the farmer holds his farm and flock").

4. *See, e.g.*, *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 10 F. Cas. 749, 750 (C.C.D.N.J. 1876) (No. 5,600) (stating that patent infringement is equivalent to a "trespass" of horse stables); *Burleigh Rock-Drill Co. v. Lobdell*, 4 F. Cas. 750, 751 (C.C.D. Mass. 1875) (No. 2,166) (noting that the defendants "honestly believ[ed] that they were not trespassing upon any rights of the complainant"); *Livingston v. Jones*, 15 F. Cas. 669, 674 (C.C.W.D. Pa. 1861) (No. 8,414) (*rev'd by Jones v. Morehead*, 68 U.S. 155 (1863)) (accusing defendants of having "made large gains by trespassing on the rights of the complainants"); *Eastman v. Bodfish*, 8 F. Cas. 269, 270 (C.C.D. Me. 1841) (No. 4,255) (Story, Circuit Justice) (comparing evidentiary rules in a patent infringement case to evidentiary rules in a trespass action).

5. *See, e.g.*, *Pennock v. Dialogue*, 27 U.S. (2 Pet.) 1, 12 (1829) (Story, J.) (recognizing that "if the invention should be pirated, [this] use or knowledge, obtained by piracy" would not prevent the inventor from obtaining a patent); *Batten v. Silliman*, 2 F. Cas. 1028, 1029 (C.C.E.D. Pa. 1855) (No. 1,106) (decrying defendant's "pirating an invention"); *Buck v. Cobb*, 4 F. Cas. 546, 547 (C.C.N.D.N.Y. 1847) (No. 2, 079) (recognizing goal of patent laws in "secur[ing] to inventors the rewards of their genius against the incursions of pirates"); *Dobson*, 7 F. Cas. at 785

This Court explained in its unanimous decision in *Pennock v. Dialogue*, 27 U.S. (2 Pet.) 1, 18 (1829), that a patent is a "title" and thus an act of invention before an application for a patent is "like an inchoate right to land, or an inceptive right to land, well known in some of the states, and every where accompanied with the condition, that to be made available, it must be prosecuted with due diligence, to the consummation or completion of the title." Similarly, in *Gayler v. Wilder*, 51 U.S. (10 How.) 477, 493 (1850), this Court recognized "the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires. [The inventor] possessed this inchoate right at the time of the assignment [to Enos Wilder]."

The *Gayler* Court's use of the common law property concept of an "assignment" is significant, *id.*, because it further confirms the extent to which this Court and lower courts in the early American Republic defined patents as private property rights. This Court and lower courts expressly incorporated real property concepts from the common law in creating conveyance doctrines in patent law. For

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(concluding that patent-assignee has been injured by "the piracy of the defendant"); *Grant & Townsend v. Raymond*, 10 F. Cas. 985, 985 (C.C.S.D.N.Y. 1829) (No. 5,701) (noting that the patented machine had "been pirated" often); *Earle v. Sawyer*, 8 F. Cas. 254, 258 (C.C.D. Mass. 1825) (No. 4,247) (Story, Circuit Justice) (instructing jury that an injunction is justified by defendant's "piracy by making and using the machine").

instance, in *Potter v. Holland*, 19 F. Cas. 1154 (C.C. Conn. 1858), Justice Story, riding circuit, surveyed in extensive detail how the common law real property doctrines of "assignment" and "license" had been applied in U.S. patent law in defining the nature of the legal interest that a patent owner conveys to a third party. *See id.* at 1156-57 (stating that "[a]n assignment, as understood by the common law, is a parting with the whole property," and that a license is a "less or different interest than . . . the interest in the whole patent"). *See also Moore v. Marsh*, 74 U.S. (7 Wall.) 515, 520 (1868) ("An assignee is one who holds, by a valid assignment in writing, the whole interest of a patent, or any undivided part of such whole interest, throughout the United States."); *Suydam v. Day*, 23 F. Cas. 473, 474 (C.C.S.D.N.Y. 1845) (distinguishing between "an assignee of a patent [who] must be regarded as acquiring his title to it, with a right of action in his own name," and "an interest in only a part of each patent, to wit, a license to use").

Federal courts from the early American Republic to the late nineteenth century consistently affirmed that "the [patent] right is a species of property," *Allen v. New York*, 1 F. Cas. 506, 508 (C.C.S.D.N.Y. 1879) (No. 232), and thus infringement is "an unlawful invasion of property," *Gray v. James*, 10 F. Cas. 1019, 1021 (C.C.D. Pa. 1817) (No. 5,719).[6] As Circuit Justice

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6. *See also Ball v. Withington*, 2 F. Cas. 556, 557 (C.C.S.D. Ohio 1874) (No. 815) (noting that patents are a "species of property"); *Carew v. Boston Elastic Fabric Co.*, 5 F. Cas. 56, 57 (C.C.D. Mass. 1871) (No. 2,398) (explaining that "the rights conferred by the

Levi Woodbury explained in 1845: "we protect intellectual property, the labors of the mind, . . . as much a man's own, and as much the fruit of his honest industry, as the wheat he cultivates, or the flocks he rears." *Davoll v. Brown*, 7 F. Cas. 197, 199 (C.C.D. Mass. 1845) (No. 3,662).

II. This Court Has Provided Constitutional Protection to Patents as Private Property Rights for Two Hundred Years.

The substantial early nineteenth-century case law that patents are private property rights is directly relevant to this case, because it underscores the uncontroversial, unanimous decision by this Court in *McClurg v. Kingsland*, 42 U.S. (1 How.) 202, 206 (1843), that the Constitution prohibits Congress from retroactively abrogating vested property rights in patents. In that case, the question was whether a patent that had issued under a subsequently repealed provision of the patent statute was still valid. The

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patent law, being property, have the incidents of property"); *Lightner v. Kimball*, 15 F. Cas. 518, 519 (C.C.D. Mass. 1868) (No. 8,345) (noting that "every person who intermeddles with a patentee's property . . . is liable to an action at law for damages"); *Ayling v. Hull*, 2 F. Cas. 271, 273 (C.C.D. Mass. 1865) (No. 686) (discussing the "right to enjoy the property of the invention"); *Hayden v. Suffolk Mfg. Co.*, 11 F. Cas. 900, 901 (C.C.D. Mass. 1862) (No. 6,261) (instructing jury that a "patent right, gentlemen, is a right given to a man by law where he has a valid patent, and, as a legal right, is just as sacred as any right of property"); *Gay v. Cornell*, 10 F. Cas. 110, 112 (C.C.S.D.N.Y. 1849) (No. 5,280) (recognizing that "an invention is, within the contemplation of the patent laws, a species of property").

unanimous opinion states bluntly that "a repeal [of a patent statute] can have no effect to impair the right of property then existing in a patentee, or his assignee, according to the well-established principles of this court." *Id.* In sum, a patent issued to an inventor creates vested property rights, and "the patent must therefore stand" regardless of Congress's subsequent repeal of the particular statute under which the patent originally issued. *Id.* The *McClurg* Court emphasized that its decision was based on the "well-established principles of this court" that constitutional security is provided to vested property rights in patents. *Id.*

Further confirming the legal status of patents as private property rights, the *McClurg* Court continued the practice of citing *real property cases* as precedent for defining and securing property rights in patents. *See id.* (citing *Society for the Propagation of the Gospel in Foreign Parts v. New Haven*, 21 U.S. (8 Wheat.) 464 (1823), which addressed the status of property rights in land under the treaty that concluded the Revolutionary War). In relying on such "well established principles" set forth in *Society*, the *McClurg* Court removed any doubt that might have existed in 1843 that patents are on par with private property rights in land as a matter of constitutional doctrine.

The 174-year-old legal rule in *McClurg* that patents are private property rights secured under the Constitution has never been reversed or limited. This

is confirmed by the holding (and substantial supporting citations) in *McCormick Harvesting Mach. Co. v. C. Aultman & Co.*, 169 U.S. 606 (1898), that once a patent is issued to an inventor "[i]t has become the property of the patentee, and as such is entitled to the same legal protection as other property." *Id.* at 609. The Federal Circuit's decision in this case, and in prior cases in which it has explicitly asserted that patents are only "public rights," cannot be reconciled with this long-established rule. *See, e.g.*, *MCM Portfolio LLC*, 812 F.3d at 1293; *Cascades Projection LLC v. Epson America, Inc.*, 864 F.3d 1309 (Fed. Cir. 2017) (Reyna, J., dissenting from denial of rehearing en banc) (critiquing the Federal Circuit's view from *MCM Portfolio* and in many follow-on decisions that patents are "public rights").

Like *McClurg*, the *McCormick* Court's decision in 1898 was not an outlier. In the late nineteenth century, this Court and lower federal courts built upon the precedents in *McClurg* and many other similar decisions in consistently holding that patents are private property rights secured under the Constitution. *See, e.g.*, *United States v. Burns*, 79 U.S. 246, 252 (1870) (stating that "the government cannot, after the patent is issued, make use of the improvement any more than a private individual, without license of the inventor or making compensation to him"); *Cammeyer v. Newton*, 94 U.S. 225, 234 (1876) (holding that a patent owner can seek compensation for the unauthorized use of his patented invention by federal officials because "[p]rivate

property, the Constitution provides, shall not be taken for public use without just compensation"); *McKeever v. United States*, 14 Ct. Cl. 396 (1878) (rejecting the argument that a patent is a "grant" of special privilege, because the text and structure of the Constitution, as well as court decisions, clearly establish that patents are private property rights).

In *Cammeyer*, for example, this Court expressly rejected an argument by federal officials that a patent was merely a public grant by the sovereign and thus they could use it without authorization. Citing the Takings Clause, the *Cammeyer* Court stated that "[a]gents of the public have no more right to take such *private property* than other individuals." *Id.* at 234–35 (emphasis added). Thus, the *Cammeyer* Court held that the Constitution protects patent owners against an "invasion of the *private rights* of individuals" by federal officials. *Id.* at 235 (emphasis added).

This Court again expressly affirmed that patents are private property rights in its summary affirmance of *McKeever v. United States*, 14 Ct. Cl. 396 (1878), in which the Court of Claims held that patents are secured under the Takings Clause as "private property" against unauthorized uses by government officials. *See Russell v. United States*, 182 U.S. 516, 531 (1901) (stating that *McKeever* was "affirmed on appeal by this court"); *United States v. Buffalo Pitts Co.*, 234 U.S. 228, 233 (1914) (citing *McKeever* and stating "affirmed by this court"). The *McKeever* court's wide-ranging, historical analysis of why U.S.

patents are "private property," as opposed to the English definition of a patent as a "grant" that issues by "royal favor," *McKeever*, 14 Ct. Cl. at 417-19, makes even more clear the profound contradiction in the Federal Circuit's contrary conclusion that patents are "public rights."

Contrary to the English view of patents as solely legal tools of governmental economic policy, the U.S. clearly and definitively recognized that American patents secured the "property in the mind-work of the inventor," *id.*, as specifically authorized under the Patent and Copyright Clause in the Constitution. U.S. Const. art. I, § 8, cl. 8 (authorizing Congress in "securing" the "exclusive Right" to "Inventors").

The *McKeever* court's opinion reflects now-classic textualist and original public meaning analysis. First, it analyzed the text of the Patent and Copyright Clause as evidence of this fundamental difference between the English Crown's *personal privilege* and the American *private property right*. The court explained that the language in this constitutional provision—the use of the terms "right" and "exclusive," the absence of the English legal term "patent," and the absence of any express reservation in favor of the government—established that the private property rights in an American patent were not on the same legal footing as the personal privileges in a patent granted by the English Crown. *McKeever*, 14 Ct. Cl. at 421. The Court further observed that this conclusion was buttressed by the

fact that the Framers empowered Congress, not the Executive, to secure an inventor's rights—placing this constitutional provision in Article I, not in Article II—which suggested they viewed patents as important private property rights secured by the people's representatives, not as a special grant issued by the prerogative of the Executive. *Id.* Although the Framers did not state their reasons for securing patents in the Constitution, the *McKeever* court concluded that they "had a clear apprehension of the English law, on the one hand, and a just conception, on the other, of what one of the commentators on the Constitution has termed 'a natural right to the fruits of mental labor.'" *Id.* at 420.[7]

Second, the *McKeever* court canvassed the federal government's interpretation of the Patent and Copyright Clause in the 100 years since the Founding Era, finding again that patents protected private

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7. The phrase "a natural right to the fruits of mental labor" invokes the classic formulation of the natural rights justification for property. *See, e.g., Vanhorne's Lessee v. Dorrance*, 2 U.S. (2 Dall.) 304, 310 (1795) (Patterson, J.) ("[T]he right of acquiring and possessing property, and having it protected, is one of the natural, inherent, and unalienable rights of man. . . . No man would become a member of a community, in which he could not enjoy the fruits of his honest labour and industry."). The *McKeever* court did not cite a source for this quote, but it may have been paraphrasing from a recently published treatise. *See* Theodore D. Woolsey et al., *The First Century of the American Republic* 443 (1876) (discussing how inventors are given "some control over the reproductions of the fruits of mental labor . . . in addition to the natural right to property").

property rights, not special grants of privilege that served only governmental policy goals. Accordingly, Congress's enactment of the patent statutes, the Executive's use of patented articles via "express contracts," and the Judiciary's interpretation and enforcement of these statutes and contracts all "forbid the assumption that this government has ever sought to appropriate the property of the inventor." *Id.* Throughout its opinion, *McKeever* repeatedly cited this Court's decisions in *Cammeyer*, *Burns* and *McClurg*—Supreme Court cases holding that the Takings Clause protects a patent as "private property."

Underlying the Federal Circuit's decision in this case and in many other cases denying patent owners' claims that the PTAB violated their rights of due process and constitutional doctrines like the separation of powers is the Federal Circuit's wrong assertion that "patent rights are public rights," *MCM Portfolio LLC*, 812 F.3d at 1293.[8] In saying this, the

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8. To reach this mistaken conclusion, the *MCM Portfolio* court relied solely on two non-patent law, administrative agency cases. 812 F.3d at 1292–93. These two modern cases address solely creatures of modern administrative statutes—procedural entitlements solely created in and adjudicated by modern regulatory regimes. *See, e.g., Atlas Roofing Co. v. Occupational Safety & Health Review Comm'n*, 430 U.S. 442, 442-443 (1977) (addressing procedural rights within the administrative regime created by the Occupational Safety and Health Act of 1970); *Tull v. United States*, 481 U.S. 412, 425-427 (1986) (addressing procedural rights within the administrative regime created by the Clean Water Act of 1972). Modern decisions by this Court

Federal Circuit directly contradicts the longstanding jurisprudence of this Court. This Court should reverse the Federal Circuit given its ahistorical argument based entirely in modern administrative law that patents are "public rights." The Federal Circuit is wrong; its decision in this case and prior cases conflict with the decisions handed down by this Court in the early American Republic and repeatedly sustained for over two-hundred years that patents are private property rights. *See* Gregory Dolin & Irina D. Manta, *Taking Patents*, 73 Wash. & Lee L. Rev. 719 (2016) (relying on this historical case law in applying modern takings jurisprudence to conclude that the PTAB effects a constitutional taking of a patent owner's private property).

III. This Court Recently Reaffirmed That Patents are Private Property Rights Secured Under the Constitution.

This Court's modern decisions are in accord with the long-standing legal principle that patents are private property rights that are secured under the Constitution. Two years ago in *Horne v. Department of Agriculture*, 135 S. Ct. 2419, 2427 (2015) (Roberts, C.J.), this Court approvingly quoted one of its decisions in 1882 that "[a patent] confers upon the patentee an exclusive property in the patented

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addressing regulatory entitlements arising in the administrative state are distinct from the constitutionally protected private property rights in patents long recognized by this Court and by Circuit Courts for over two hundred years.

invention which cannot be appropriated or used by the government itself, without just compensation, any more than it can appropriate or use without compensation land which has been patented to a private purchaser" (quoting *James v. Campbell*, 104 U.S. 356, 358 (1882)). Notably, sixteen years after the *James* decision, the *McCormick* Court cited it in 1898 along with numerous other decisions by this Court as precedent for the same proposition:

> It has been settled by repeated decisions of this court that when a patent has received the signature of the secretary of the interior, countersigned by the commissioner of patents, and has had affixed to it the seal of the patent office . . . . It has become the property of the patentee, and as such is entitled to the same legal protection as other property.

McCormick, 169 U.S. at 608-09 (citing *James* and other cases, including *Cammeyer*). The legal rule reaffirmed two years ago in *Horne*—patents are private property rights secured under the Constitution—is settled doctrine with a provenance in an unbroken line of decisions by this Court reaching back to the early American Republic.

The *Horne* Court's reaffirmation of this legal rule was similarly confirmed nineteen years ago by this Court when it held that patents are private property rights secured under the Due Process Clause of the Fourteenth Amendment. *See Fla. Prepaid*

Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627 (1999) (holding that patents are private property rights secured under the Due Process Clause of the Fourteenth Amendment).

To reverse the Federal Circuit in this case would not be the first time this Court has stopped the Federal Circuit in ignoring settled legal doctrine. In 2002, this Court warned the Federal Circuit in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002), that it must respect "the legitimate expectations of inventors in their property" and thus it cannot abrogate legal doctrines that have existed since the early nineteenth century. *Id.* at 739. In *Festo*, this Court brought an end to a decade-long attempt by the Federal Circuit to abrogate the longstanding infringement doctrine known as the doctrine of equivalents. *Id.* The doctrine of equivalents is based in this Court's case law reaching back to the Antebellum Era, *see, e.g.*, *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), just like the settled constitutional doctrine that patents are private property rights. As Chief Justice John Roberts stated in *eBay Inc. v. MercExchange, L.L.C.*, 126 S. Ct. 1837 (2006), nineteenth-century patent law should be accorded significant weight by modern courts in securing the property rights in patents. *Id.* at 1841–42 (Roberts, C.J., concurring).

CONCLUSION

For the foregoing reasons, *amici* urge this Court to reverse the Federal Circuit and affirm the

longstanding rule in patent law and constitutional law that patents are private property rights secured under the Constitution.

Respectfully submitted,

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